

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JACQUES BENZARIA

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Appeal No. 94-4150  
Application 07/911,354<sup>1</sup>

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ON BRIEF

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Before KIMLIN, GARRIS and ELLIS, Administrative Patent Judges.  
GARRIS, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal which involves claims 2-11, 17-21, 23, 24, 26 and 27 which are all of the claims remaining in the application.

The subject matter on appeal relates to a method of establishing contact between fluids and solid materials which comprises passing a fluid through a container filled with

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<sup>1</sup> Application for patent filed July 9, 1992. According to appellant, the application is a division of Application 07/790,984, filed November 13, 1991. (ABN)

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granular solid materials wherein the container comprises four substantially triangular faces which substantially constitute a tetrahedron. This appealed subject matter is adequately illustrated by independent claim 17 which reads as follows:

17. A method of establishing contact between fluids and solid materials, said method comprising passing a fluid through a container filled with granular solid materials, said container comprising a closed casing permeable to said fluid, said casing having pores sufficiently small to retain said granular solids, said container comprising four substantially triangular faces which substantially constitute a tetrahedron, and contacting said fluid with the granular solids within said container, said container being sufficiently rigid to maintain the substantially tetrahedron shape during said contacting step.

The references relied upon by the examiner in the rejections on appeal are:

Smith	4,232,177	Nov. 4, 1980
Mitchell	4,417,433	Nov. 29, 1983
Margel	4,732,811	Mar. 22, 1988
Haney et al. (Haney)	4,792,399	Dec. 20, 1988

Claims ?2-15 [sic, 2-11], 17-21, and 23-27 [sic, 23, 24, 26 and 27] are rejected under 35 USC § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter

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of which applicant regards as the invention? (Supplemental Examiner's Answer, page 3).

Claims 2-11 and 17-20 are rejected under 35 USC § 103 as being obvious over Haney or Margel.

Claims 2-9, 11 and 17-21 are rejected under 35 USC § 103 as being obvious over Smith.

Finally, claims 17, 5, 8, 23 and 24 are rejected under 35 USC § 102(b) as being anticipated by or under 35 USC § 103 as being obvious over Mitchell.

As a preliminary matter, we note that the appealed claims will stand or fall together in accordance with their groupings in the above noted rejections; see 37 CFR § 1.192(c)(5) (1993) and page 2 of the Supplemental Examiner's Answer.

#### **OPINION**

We will sustain the examiner's § 102 and § 103 rejections of claims 17, 5, 8, 23 and 24 over Mitchell, but we will not sustain any of the other rejections advanced by the examiner on this appeal.

#### **THE SECTION 112 REJECTION**

This rejection is not well founded for the reasons detailed by the appellant on pages 3 through 5 of his Supplemental Brief.

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We add the following comments for emphasis and completeness.

The examiner's burden of proof in calling into question the enablement of an applicant's disclosure requires that the examiner advance acceptable reasoning inconsistent with enablement. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982). In the case before us, the examiner has advanced no such acceptable reasoning. In particular, the mere fact that the independent claims on appeal are directed to a method of establishing contact between fluids and solid materials generally is not, in and of itself, inconsistent with enablement as the examiner seems to believe. It follows that we discern little if any merit in the examiner's position that the here rejected claims are not enabled within the meaning of the first paragraph of § 112.

Similarly, the examiner is incorrect in believing that the breadth of the rejected claims renders them offensive to the second paragraph of § 112. It has been long established that breadth is not indefiniteness. In re Gardner, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970). As for the examiner's view that the independent claim term "substantially" renders the appealed claims unclear, we agree with the appellant that one with ordinary skill in the art would have a reasonable appreciation of

the here claimed subject matter notwithstanding the presence of this term. In this latter regard, we emphasize the appellant's point that Figure 1 of his drawing shows a container shape which is plainly not an exact tetrahedron in view of the seam disposed on the right side of the figure and therefore is properly and accurately characterized as "substantially" constituting a tetrahedron in accordance with the appealed claims.

For the reasons set forth above and in the appellant's Supplemental Brief, we cannot sustain the examiner's § 112, first and second paragraphs, rejection of claims 2-11, 17-21, 23, 24, 26 and 27.

**THE SECTION 103 REJECTION BASED ON  
HANEY, MARGEL or SMITH**

On pages 5 and 6 of his Supplemental Answer, the examiner acknowledges that the references under consideration do not disclose a container for solid materials in the shape of the tetrahedron but argues that one of ordinary skill in the art would have used any shape container. However, the examiner has proffered no evidence whatsoever in support of his argued position. We are constrained, therefore, to regard this position as founded upon conjecture, speculation or assumptions on the examiner's part. Since a rejection based on § 103 must rest on a

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factual basis rather than conjecture, speculation or assumptions (In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967)), it is clear to us that we cannot sustain the examiner's

§ 103 rejections of claims 2-11 and 17-20 over Haney or Margel or of claims 2-9, 11 and 17-21 over Smith.

#### **THE REJECTION BASED ON MITCHELL**

With the respect to this rejection, the appellant argues that ?materials which swell like [Mitchell's] tea are not embraced within either the original or present scope of the claims, which recite ?granular materials?? (Supplemental Brief, page 7). However, independent claim 17 contains no recitation which would exclude materials which swell from the claim phrase ?granular solid material?. Moreover, the appellant points to nothing in his specification disclosure, and we find nothing independently, which requires the claim 17 phrase ?granular solid material? to be interpreted as excluding materials which swell. We therefore share the examiner's determination that the independent claim under review encompasses, rather than excludes as argued by the appellant, granular materials such as the tea of

Mitchell.

The appellant also argues that "the container [of the appealed claims] is sufficiently rigid to maintain its substantially tetrahedral shape during contact" whereas "[t]he Mitchell container does not do so" (Supplemental Brief, page 7). For a number of reasons, this argument is unconvincing.

Certainly, the tea bag of Mitchell exhibits a tetrahedral shape when disposed in the air from its strip 13 and tab 14 (e.g., see Figure 3 of the drawing and lines 10 through 25 in column 2). The air/tea contact which occurs in this disposition is encompassed by the broad claim 17 recitation of "contact between fluids and solid materials" since the claim phrase "[granular] solid materials" embraces tea as previously explained and since the claim term "fluids" embraces a gas including air. In any case, it is appropriate to conclude that Mitchell's tea bag maintains its tetrahedral shape, which is described as "its stable, three-dimensional configuration" (column 2, line 25; emphasis added), even when disposed in water in light of patentee's teaching that his bag does not collapse when immersed (see lines 26-29 in column 2).

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Because the here rejected claims fail to distinguish over Mitchell in any of the ways argued by the appellant, we will sustain the examiner's § 102 and § 103 rejections based on Mitchell of independent claim 17 and claims 5, 8, 23 and 24 which depend therefrom.

**SUMMARY**

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED-IN-PART**

EDWARD C. KIMLIN )  
Administrative Patent Judge )  
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) BOARD OF PATENT



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BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOAN ELLIS	)	
Administrative Patent Judge	)	

MILLEN, WHITE & ZELANO  
Arlington Courthouse Plaza 1  
Suite 1201  
2200 Clarendon Blvd.  
Arlington, Virginia 22201